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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/309,264 05/11/99 YODA

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EXAMINER

MM91/0816

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ARTUNITESUS, LPAPER NUMBER

DATE MAILED: 08/16/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/309,264

Applicant(s)  
Yoda et al.

Examiner  
Lydia De Jesús

Group Art Unit  
2859



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☒ Claim(s) 1-12 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Claim Objections***

1. Applicant is advised that should claim 7 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, and similarly claim 3, is confusing due to the limitation “the direction of said probe of said coordinate measuring machine is the same as that of a tool” since it unclear whether this limitation refers to the direction of motion of the probe being parallel to, or in the same plane as, the direction of motion of the tool or Applicant’s intention is to describe the direction of the axis of the probe with respect to that of the tool.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 4-6, 9-10, and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by the Prior Art method disclosed by Applicant in Page 2 of the Specification [hereinafter Prior Art method].

The Prior Art method comprises the steps of placing a work on a waiting position [via 40] after the work has been machined by a machining tool [20] and bringing a probe of a coordinate-measuring machine close to said work and then measuring the forms and dimensions of said work, said coordinate-measuring machine being arranged in the vicinity of said machine tool as shown in Fig. 13.

The Prior Art method is performed by an apparatus (conventional machining line) as that shown in Fig. 13 which comprises a changer/conveyer for moving a work between a waiting position and a machining position at machining tool [20] and a coordinate-measuring machine [50] for bringing a probe thereof close to said work, having been machined by said machining tool, placed on a waiting position [at 50], to thereby measure the forms and dimensions of said work.

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Inherently the coordinate measuring machine is capable of taking refuge to such a position so as not to prevent or interfere with the movement of the work via a refuge means.

The Prior art also discloses the use of a controlling means 17 to synchronize the operation of the machining tool, the changer, and the coordinate measuring machine and receive the measurement data of the coordinate measuring machine. Hence, the Prior Art inherently includes the communication of signals, i.e. measuring enabling signal, between these elements and the controlling means required to synchronize the operation of the machining line.

Furthermore, the use of "adapted to" in line 3 of claim 9 makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is "adapted to" to perform a function only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

With respect to claim 12: The Prior Art discloses a coordinate measuring machine in the vicinity of a machining tool for getting a probe thereof close to a work, having been machined by said machining tool and placed on a waiting position, to thereby measure the forms and dimensions of said work.

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***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-3, 7-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Prior Art and Plath et al.[DE4126532A1, hereinafter Plath].

The Prior Art discloses an apparatus and method as claimed, as stated above in paragraph 5, but fails to explicitly show the direction of motion of the probe and the tool, does not show a refuge means adapted to cause said coordinate-measuring machine to take refuge in a linear manner, and lacks a rotating means for rotating the work which is placed on a measuring position.

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Plath shows alternate structures commonly used as a changer for moving a work between a waiting position and a measuring position for measuring the dimensions of said work by a coordinate-measurement machine having a probe which moves in a horizontal direction. Plath teaches that it is known in the art to use a changer in the form of a conveyer [Fig. 8], a rotatable [Fig. 10], or a table displaced towards and away from the coordinate-measuring machine by a predetermined distance and having a rotating means for rotating the work which is placed on a measuring position [Fig. 12].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the changer/conveyer of the conventional machining line disclosed in the Prior Art for a changer having a rotatable means and to share the working surface (table with rotatable means shown in Fig. 12 of Plath) of the coordinate-measuring machine with the machining tool as suggested by Plath in order to allow the performance of the apparatus with a large size work more accessible and operable.

The resulting apparatus of the Prior Art and Plath enables the machining tool and the coordinate measuring machine to operate, with the coordination provided by the controller, without interfering with one another.

Furthermore, the use of "adapted to" in line 2 of claim 7 and line 2 of claim 8 makes what follows a functional statement and not a positive limitation because it has been held that the recitation that an element is "adapted to" to perform a function only requires the ability to so

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perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weckenmann et al. discloses a coordinate-measuring machine having multiple probes and the work being placed on a rotatable means. Hemmelgarn discloses a rotary table for a coordinate measuring machine with a probe displacing in a horizontal plane. Maag discloses a coordinate measuring machine for testing the profile of a gear. DE 3419546, EP 464431A2, and EP 456276A1 disclose related apparatus.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lydia M. De Jesús whose telephone number is (703) 306-5982.

Any inquiry of a general nature or related to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1782. The fax number for this Group is (703) 308-7722.



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